REMARKS

Following entry of the present amendment, Claims 1-14, 17-22, 27, and 29 remain in the application for consideration. Claims 23, 24, and 28 are currently cancelled without prejudice. Claims 2 and 29 are herein amended to correct a typographical error and to further define the invention. Claims 15, 16, 25 and 26 were previously cancelled without prejudice.

In the present Office Action, Claims 1, 2, 5-14, 17-24, and 27-29 stand rejected. Claims 3, 4 stand objected to.

Rejections Under 35 USC §112

Claim 23 was rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking enablement in view of the disclosure. To address this rejection, Applicants herein cancel without prejudice Claim 23 and Claims 24 and 28 which are dependent thereon, and now submit that this rejection is moot.

Claim 29 was also rejected under 35 U.S.C. §112, first paragraph as allegedly not providing enablement for treating the recited scope of skin disorders or diseases. The Examiner states that the specification is enabling for compounds according to formula (I) for treating certain skin disorders or

disease, but does not reasonably provide enablement for compounds that can treat *any* or *all* skin disorders or diseases.

Applicants herein amend Claim 29 to recite specific skin disorders and skin diseases that can be treated by formula (I) (and as originally recited in claim 28), as suggested by the Examiner. Therefore, Applicants submit that this rejection is overcome.

Claim 29 was further rejected under 35 U.S.C. §112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner states that the specification does not provide any guidance as to the intended retinoid or vitamin D analog that is in combination with the compound of claim 1.

To address this rejection, Applicants herein amend claim 29 to recite a step of administering to a patient a pharmaceutical composition comprising a therapeutically effective amount of a compound of claim 1. Applicants submit by this amendment, this rejection is overcome.

Rejections under 35 U.S.C §101

Claim 23 was rejected under 35 U.S.C. §101 as allegedly being unsupported by either a specific and substantial asserted

utility or a well established utility. Applicants herein cancel claim 23, thereby rendering this rejection moot.

Double-Patenting and 35 U.S.C. §§102/103 Rejections

The Examiner rejected Claims 1, 2, 5-14, 19-24, and 27-29 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,395,784 to Ryono. The Examiner additionally rejected Claims 1, 2, 5-14, 17-24, and 27-29 over 35 U.S.C. §§102(e), (f) and 35 U.S.C. §103(a). Applicants submit that the Ryono reference is not a proper reference against the currently filed application, and that these rejections should be withdrawn.

The Ryono patent patent was filed May 31, 2001 and claims priority to U.S. Provisional patent application 60/871,347 filed on June 7, 2000.

The present application, by contrast, was filed in the United States under 35 USC §371 on September 14, 2001, and claims priority to PCT/IB99/02084 filed on December 23, 1999. Applicants submit that the filing date of a national stage application is the filing date of the international stage application. See MPEP §1893.03(b), 35 USC §363, and 37 CFR §1.496(a). Accordingly, Applicants submit that the effective filing date of this application is December 23, 1999. Moreover,

the international application properly claimed priority to GB 9828442.5 filed December 24, 1998, and such priority is to be acknowledged by the U.S Patent and Trademark Office. MPEP 1893.03(c).

Applicants therefore submit that both the filing date and priority date of the present application antedates the filing date of the Ryono '784 reference. Accordingly, this reference is not proper prior art, and the rejections based on 35 USC §§102 and 103 should be withdrawn.

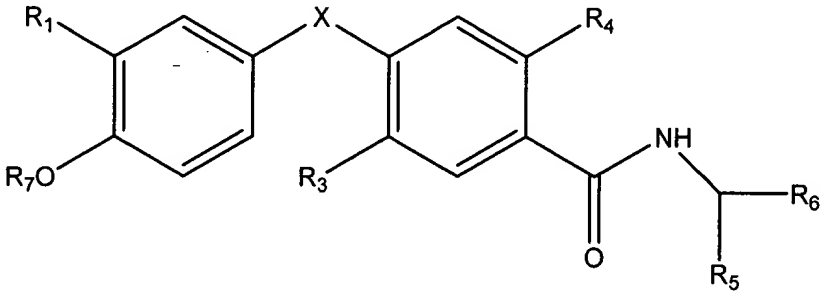
Double Patenting Rejection

Claims 1, 2, 5-14, and 19-24 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,395,784 to Ryono. Applicants respectfully submit that this rejection is untenable and should be withdrawn.

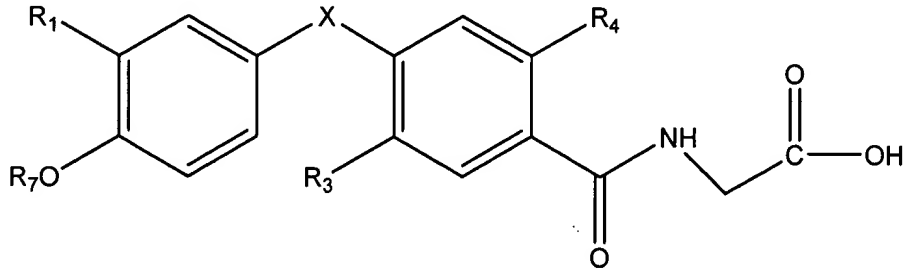
Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. Further, a double patenting rejection of the obviousness type is analogous to an alleged

failure to meet the nonobviousness requirement of 35 USC §103 except that the patent principally underlying the double patenting rejection is not considered prior art.. Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 USC §103 obviousness determination. MPEP §804.

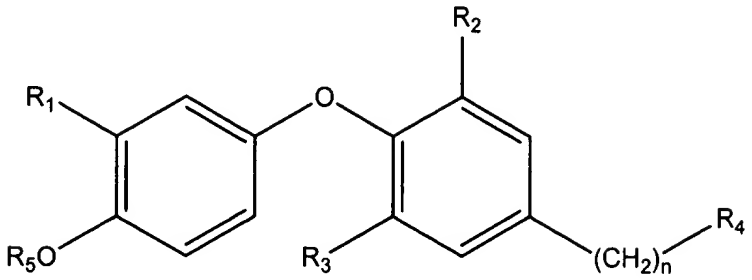
Applicants submit that presently claimed invention is not obvious over U.S. Patent No. 6,395,784 to Ryono. Ryono discloses thyroid receptor ligands which have the structure



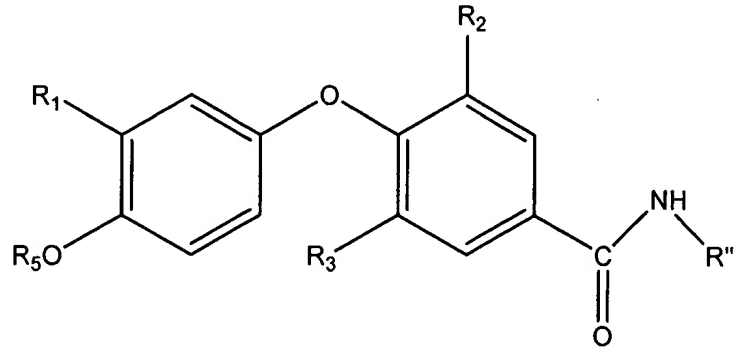
where, in particular, R_5 is hydrogen or lower alkyl, and R_6 is carboxylic acid, or ester, or a prodrug. In one embodiment, R_5 is hydrogen, and R_6 is carboxylic acid, giving a structure of



In contrast, claim 1 of the present invention recites a compound having the structure



and includes, among other things, a proviso that when n=0, R_4 can only be a carboxylic acid amide (CONR'R", where R' and R" are the same or different and are independently selected from hydrogen, alkyl, aryl, and heteroaryl substituted or unsubstituted) or an acylsulphonamide. Thus in one embodiment, the compound of the invention has the structure



where R" is alkyl, aryl, or heteroaryl substituted or unsubstituted.

Applicants submit that Ryono does not disclose or suggest the presently claimed invention. Ryono does not disclose or suggest an alkyl, aryl, or heteroaryl substituted or

unsubstituted as substituents on the carboxylic acid amide moiety. Rather, in all cases, Ryono disclose a carboxylic acid, ester thereof, or prodrug thereof as substituents at this position. No disclosure or suggestion is made by Ryono to employ an alkyl, aryl or heteroaryl moiety at this position. Applicants therefore submit that the presently claimed invention is not obvious over Ryono and that this rejection is overcome.

Claim Objections

Claims 3 and 4 were objected to as being dependent on rejected base Claims. Applicants respectfully submit that Claims 3 and 4 are properly dependent on base claims that Applicants believe are now allowable. Accordingly, Applicants submit that these objections are traversed.

Applicants now submit that the claims are in condition for allowance, and respectfully request reconsideration and issuance of a timely Notice of Allowance.

If the Examiner has any questions or feels that a discussion with Applicants' representative would expedite prosecution, the Examiner is invited and encouraged to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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Date: 12 AUG 2004